

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Matthew LERNER et al.

Application No.: 10/777,046

Confirmation No.: 3923

Filed: February 13, 2004

Art Unit: 2178

For: CLIPPING VIEW

Examiner: Wilson W. Tsui

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

As required under § 41.37(a), this brief is filed three months after the Notice of Appeal filed in this case on April 9, 2008, and is in furtherance of said Notice of Appeal. Accordingly, an appropriate Petition and fee for a One-Month Extension of Time is filed herewith.

The fees required under § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1205.2:

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I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

MICROSOFT CORPORATION

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 16 claims pending in application.

B. Current Status of Claims

1. Claims canceled: 1, 3-4, 8, 11-12, 14, 17-18, 20
2. Claims withdrawn from consideration but not canceled: N/A
3. Claims pending: 2, 5-7, 9, 10, 13, 15, 16, 19, 21-26
4. Claims allowed: N/A
5. Claims rejected: 2, 5-7, 9, 10, 13, 15, 16, 19, 21-26

C. Claims On Appeal

The claims on appeal are claims 2, 5-7, 9, 10, 13, 15, 16, 19, 21-26

IV. STATUS OF AMENDMENTS

Applicant filed an Amendment after Final Rejection on February 16, 2008. The Examiner responded to the Amendment after Final Rejection in an Advisory Action mailed March 17, 2008. In the Advisory Action, the Examiner indicated that Applicants' proposed amendments to claims 2, 5-7, 9, 10, 13, 15, 16, 19, 21-26 would not be entered.

Accordingly, although the Amendment was not entered, Applicants believe that the decision not to enter the Amendment was in error, and therefore, have included those claim amendments in the following Appendix, to claims 2, 5-7, 9, 10, 13, 15, 16, 19, 21-26. The claims enclosed herein as Appendix A do not incorporate the amendments to claims 2, 5-7, 9, 10, 13, 15, 16, 19, 21-26 as indicated in the paper filed.

V. SUMMARY OF CLAIMED SUBJECT MATTER

In making reference herein to various portions of the Specification and Drawings in order to explain the claimed invention, Applicants do not intend to limit the claims; all references to the Specification and Drawings are illustrative unless otherwise explicitly stated.

Aspects of the invention are directed to providing a better presentation of annotations in their associated contexts. (Page 2, lines 12-15). Typically, attempting to capture annotations in the related markups in an electronic fashion is at best cumbersome. Even with the existence of a stylus, providing and displaying users' annotations and other markups in a fashion that is readily identifiable and efficient to the user has been difficult. Although, thumbnails may generated to display certain annotations, the problematic display of a thumbnail image, which must result in a significantly smaller representation of the corresponding annotations within the content, leave much to be desired as to the usefulness of any marked-up notes or otherwise annotated information. (Page 2, lines 1-9).

In various embodiments the system provides and ink platform as a set of COM (Component Object Model) services that an application can use to capture, manipulate and store ink. One service enables an application to read and write using the disclosed representations of ink. The ink platform may also include a mark-up language including a language like the

extensible mark-up language (XML). Further, the system may use DCOM as another implementation. Yet further implementations may be used including the Win 32 programming model and .Net programming model from Microsoft Corporation. (Page 10, lines 3-10).

As illustrated in Figure 3, a document with content and various annotations in accordance with aspects of the present invention is shown. Document 301 includes electronic ink represented by ink strokes 302-304, image data represented by picture 308, and text information represented by text 310. (Page 10, lines 13-16).

As illustrated in Figure 4, information associated with each annotation as shown in Figure 3 relates to content. Figure 4 illustrates the designation of context information relevant to each annotation. A bounding box may or may not encompass all related content. (Page 11, lines 108). In one aspect of the invention, as illustrated by bounding boxes 401-405 within Figure 4, a user may show his annotation and thereby convey a quick understanding of the relevant portions (according to him) of the particular document. All bounding boxes may be rendered separately. (Page 11, lines 21-25). Furthermore, as illustrated in Figure 5, one aspect of the invention shows grouping of annotations in accordance with aspects of the present invention the resulting annotations being displayed to as user may be ordered based upon underlying contextual information. Furthermore, as illustrated in Figure 5, for example, and as when applied at an operating system level, aspects of the present invention permit clippings to be gathered across documents from different applications. (Page 12, lines 20-25).

Still further, and as illustrated in Figure 6, annotations on electronic ink may be grouped in accordance with aspects of the present invention and as displayed within Figure 6, for example, highlight 601, 602, 603 and 604 may be considered annotation separate from the

underlying ink document even though the difference between the highlight and the original ink document may be as small as a user using a different color and/or different widths pen tip. (Page 6, page 13, lines 7-15).

As shown, within Figure 6, and Figures 7 and 8, which illustrate processes for combining and displaying annotations in accordance with aspects of the present invention, the user may develop methods by which certain filtering criteria may be employed which provide the benefit of reducing the number of independent annotations and clips must be searched during a filtering process. (See Figures 6-8, page 14, lines 20-24).

Turning to the claims, claims 9, 13, 15, 19, 21 and 23 are independent claims. Claims 2, 5, 6, 7, 10, 16, 22, 24, 25 and 26 are dependent claims.

Independent claim 9 is directed to a method of displaying clips comprising the steps of receiving at least two sets of annotations and related content, the at least two sets being from non-contiguous portions of a document or portions of different documents (Page 14, lines 2-7). The method comprises displaying clips that may come from one or more documents from one or more applications (pages 15-16, lines 24-2). Combining said at least two sets to form a combination consisting of non-contiguous portions of a document or portions of different documents or both. (Figure 11, lines 3-9). And filtering said combination of said at least two sets and displaying the filtered combination of said at least two sets. (Page 17, lines 14-19).

Independent claim 13 is directed to a method of storing an accessing clip comprising the steps of receiving data regarding an annotation, and the data will include user interface to allow various selections of an active content change when since the previous access session the active content has changed. (Page 16, lines 24 – page 17, line 1). Further, the method comprises storing

the link to context information with said annotation data and storage. (Page 17, lines 2-26). Storing associations regarding at least two documents from which said annotation originates, wherein selection of said annotation accesses the at least two documents to display said annotation based on active content selection. (Page 17, lines 4-10).

With regards to independent claim 15, independent claim 15 is directed to a computer-readable medium having a program stored thereon, said program for displaying clips and comprising the steps of receiving at least two sets of an annotation and a related content and the associated content will include a user interface to allow various selections of an active content change when since the previous renderable image upon the user interface, the active content associated with the annotation has changed. (Page 16, line 24 – page 17, line 12). Combining said at least two sets to form a combination consisting of non-contiguous portions of a document or portions of different documents or both and filtering said combination of said at least two sets based on the active content selection and displaying the filtered combination of said at least two sets. (Page 16, lines 24 – page 17, line 12).

Independent claim 19 is directed to a computer-readable medium having a program stored thereon, said program for storing an accessing clips and comprising the steps of receiving data regarding an annotation, the data regarding the annotation being from at least two sets from non-contiguous portions of a document or portions of different documents and the data will include a user interface to allow various selections of an active content change when since the previous access session the active content change has changed (Page 16, lines 12-23). Storing a link a context information with said annotation data in a storage and storing association regarding at least two documents from which said annotation originate wherein selection of said

annotation accesses the at least two documents to display said annotation on the active content selection. (Page 16, line 24 - page 17, line 12).

Independent claim 21 is directed to a system for showing clips of content annotations comprising an input for receiving annotations associated with the content a processor for creating a renderable image having clips, wherein at least one of said clips is a combination of two or more annotations and their associated content and the associated content will include a user interface to allow various selections of an active content change when since the previous renderable image upon the user interface, the active content associated with the annotation as changed, said processor executing instructions including (Figure 11, page 15, lines 2 - page 16, line 9). Encompassing a first content and associated annotation in a first bounding box, encompassing a second content and associated annotation in a second bounding box, wherein the first and second bounding boxes are non-contiguous, and combining the first bounding box and the second bounding box to form one of said clips based on the active content selection, and an output for outputting said renderable image. (Figure 4, page 11, lines 1-20 and page 11, line 21 – page 12, line 9).

Independent claim 23 is directed to a system for showing clips of content and annotations comprising an input for receiving annotations associated with content, a processor for creating a renderable image having clips wherein at least one of said clips is a combination of two or more annotations and their associated content and the associated content will include a user interface to allow various selections of an active content change when since the previous renderable image upon the user interface, the active content associated with the annotation has changed, said processor executing instructions including (Figure 11, and page 16, line 12 – page 17, line 12).

Dependent claim 2 includes at least one of said clips includes additional content (Figure 4, and page 11, lines 5-7).

Dependent claim 5 further includes a storage storing said annotation and an image of the first content associated with the annotation. (Page 14, lines 8-11).

Dependent claim 6 further includes a storage storing said annotations and a link to said content. (Page 15, lines 22-24).

Dependent claim 7 further includes a storage storing said annotation and an active image of first content associated with the annotations wherein the first content changes over time. (Page 17, lines 4-12).

Dependent claim 10 further includes storing said combination of at least two sets. (Page 17, lines 4-12).

Dependent claim 16 further includes storing said combination of said at least two sets. (Page 17, lines 4-12).

Dependent claim 22 further includes prior to combing the processor executed instructions which determine that the first bounding box and the second bounding box are within a threshold distance from each other in a document, wherein the third content without an associated annotation is located in a third region associated between a first and second regions. (Figure 5, and page 12, lines 3-9).

Dependent claim 24 further includes wherein prior to combining a processor executes instructions which determine that the first region and the second region are within a threshold distance from each other in a document, wherein third content without an associated annotation

is located in the third region located between the first and second regions. (Figure 5, and page 12, lines 3-9).

Dependent claim 25 further includes wherein said annotations are from different documents. (Page 12, lines 19-20).

Dependent claim 26 further includes wherein said documents are from different applications. (Page 12, lines 19-20).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claim 2 stands rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,766,494 to Price et al. (hereinafter "Price"), U.S. Patent No. 6,667,876 to Schilit et al. (hereinafter "Schilit '876") and U.S. Patent No. 5,592,568 to Wilcox (hereinafter "Wilcox") in combination and further in view of U.S. Patent No. 6,279,014 to Schilit et al. (hereinafter "Schilit '014"). Claims 5-7 and 21-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Price and Schilit '876 and further in view of Wilcox.

Claims 9, 10, 15 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Price and Schilit '876 and in further view of U.S. Patent No. 6,551,357 to Madduri (hereinafter "Madduri").

Claims 13 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Price in view of Schilit '876.

Claim 26 stands rejected under 35 U.S.C. § 103(a) being unpatentable over Price and Schilit '876 and Wilcox and further in view of Madduri. The rejections of claims 2, 5-7, 9, 10, 13, 15, 16, 19 and 21-26 are being appealed.

VII. ARGUMENT

The current Final Office Action, dated October 9, 2007, has attempted to offer Price in view of Schilit '876 to render claims 13 and 19 obvious under 35 U.S.C § 103(a) and has attempted to use the same combination in addition to, and in view of the additional references of Wilcox, Schilit '014, and/or Madduri over claims 9, 15, 21 and 23, which comprise the additional independent claims, or as relying at least in part on the Price and Schilit '876 reference in combination over the independent claims, and the other dependent claims. Insofar as claims 13 and 19 appear to be the focus of the Examiner's combination of rejections, the Applicants have attempted to parce through the Examiner's arguments and relied upon in the foregoing Final Rejection as set forth in more detail below.

Applicants respectfully disagree with the current attempt to reject essentially all of the pending claims, either directly or indirectly over the Price and Schilit '876 reference.

A. Claim 2 is patentably distinguishable over the combination of Price, Schilit '876, Wilcox and Schilit '014.

Insofar as claim 2 depends from independent claim 23, and independent claim 23 is allegedly rejected over the combination of Price, Schilit '876 and Wilcox and further in view of Schilit '014, Applicants respectfully assert that the asserted combination fails against both independent claim 23 and similarly dependent claim 2. Furthermore, as previously asserted in numerous responses, both Schilit '014 and '876 focus upon a single document or a collection of

individual documents all supported by a common word-processing application, for example. Nowhere in either Schilit reference is there any mention of an active content element that remotely suggests the inventive aspect of at least that element found within Applicants' claimed invention. Furthermore, nowhere is there found within either Schilit reference an active content element being further associated with an annotation, and offering a combination of two or more annotations and their associated content and the associated content being included in a user interface, as claimed in Applicants' claimed invention. Therefore, the asserted combination of Price, Schilit '876, Wilcox and Schilit '014 fails to support a *prima facie* case of obviousness for claim 2 and claim 23.

After close review of the text accompanying the Advisory Action of March 17, 2008, Applicants are still concerned as to whether the Examiner in charge has fully grasped the arguments and continued assertions, as recently made in the Amendment After Final Rejection on February 16, 2008.

For example, the Examiner has gone to great lengths to reproduce portions of the arguments made in the Amendment filed after final rejection, however, the Examiner has completely disconnected those arguments (as made in the Amendment After Final Rejection) from the salient claims that they had been so carefully crafted to support.

The Examiner discusses his *incorrect* interpretation of the claim amendments made to claims 7 and 22 as reflecting the argument that the active element of the active content 1202, for example, in this context should provide the Examiner with enough basis by which to construe the claims in a fashion that clearly distinguish over the prior art made of record.

The Examiner then admits that the specification and presumably the arguments offered with the Amendment After Final Rejection *are sufficient to distinguish over the prior art*. However the Examiner discounts these additional arguments for the simple fact that the Examiner did not apparently carefully read the remarks to accompany the Amendment filed After Final Rejection.

Specifically, and although the Examiner admits that the specification may, in fact, contain subject matter which if the Applicants choose, may be used to amend the claims. Applicants respectfully assert that they have already made such amendments. Applicants accordingly have distinguished the claimed invention over the prior art. The distinguishing amendments relate to the distinguishing remarks for several other amended claims, for example claims 13 and 19.

Therefore, based on the admission by the Examiner, and the positive recitation of the distinguishing characteristics found for example within claims 13 and 19, which recite

“receiving data regarding an annotation, and the data will include a user interface to allow various selections of an active content change when since the previous access session the active content has changed,”

This is to say, that this claimed subject matter as admitted by the Examiner, should be construed to distinguish the claimed invention over the applied prior art, to include Price, Madduri, Wilcox, Schilit '014 and Schilit '876.

Accordingly, Applicants respectfully assert that this failure to closely read and examine the remarks offered in the Amendment After Final Rejection, and allegedly failure to appreciate the claimed invention as made note of in the same Amendment After Final Rejection and also indicating omissions earlier in time; amount to at least one instance of *clear error* by the Examiner. Accordingly, Applicants believe that this rejection based upon the asserted combination is improper and must be withdrawn.

B. Claims 5-7 and 21-25 are patentable distinguishable over the combination of Price, Schilit '876 and Wilcox.

Claims 21 and 23 are independent claims and stand rejected under 35 U.S.C. § 103 over Price, Schilit '876 and Wilcox. Claims 5-7, 22 and 24-25 depend from claims 21 and 23. As the prosecution record clearly supports, the combination of Price, Schilit '876 and Wilcox fails to disclose or suggest at least one claimed feature of all of the rejected claims. Therefore, the asserted combination of Price, Schilit '876 and Wilcox fails to support a *prima facie* case of obviousness for claims 5-7 and 21-25.

Accordingly, for at least the same reasons asserted with regards to the improper assertion and admission of distinguishable claimed subject matter, the asserted combination of Price, Madduri, Wilcox, Schilit '014 and Schilit '876 fail to suggest or teach Applicants' claimed invention for at least the arguments and facts stated above. Insofar as the Examiner has apparently relied upon those same alleged teachings over claims 5-7 and 21-25, Applicants respectfully assert that the combination of Price, Schilit '876 and Wilcox suffers from the same deficiencies as asserted above.

C. Claims 9, 10, 15 and 16 are patentable distinguishable over Price, Schilit '876 and Madduri.

Claims 9 and 15 are independent and stand rejected under 35 U.S.C. § 103(a) over Price, Schilit '876 and Madduri. Claims 10 and 16 depend directly from independent claims 9 and 15, respectively. As the prosecution record clearly supports, the combination of Price, Schilit '876 and Madduri fails to support a *prima facie* case of obviousness for claims 9, 10, 15 and 16.

D. Claim 26 is patentably distinguishable over Price, Schilit '876, Wilcox and Madduri.

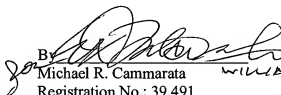
Claim 26 depends indirectly from claim 23, and for at least the same basis asserted against claim 23 and accordingly under the asserted additional combination of Price, Schilit '876, Wilcox and Madduri, fails to disclose or suggest at least one claimed feature of the rejected claim 26. Therefore, the asserted combination fails to support a *prima facie* case of obviousness for claim 26.

VIII. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A include the amendments filed by Applicant on February 16, 2008, and do not include the amendment(s) filed on February 16, 2008.

Dated: July 9, 2008

Respectfully submitted,

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APPENDIX A

Claims Involved in the Appeal of Application Serial No. 10/777,046

1. (Canceled)

2. (Previously Presented) The system according to claim 23, wherein said at least one of said clips includes additional content.

3-4. (Canceled)

5. (Previously Presented) The system according to claim 23, further comprising:
a storage storing said annotation and an image of the first content associated with the annotation.

6. (Previously Presented) The system according to claim 23, further comprising:
a storage storing said annotations and a link to said content.

7. (Previously Presented) The system according to claim 23, further comprising:
a storage storing said annotation and an active image of the first content associated with the annotation, wherein the first content changes over time.

8. (Canceled)

9. (Previously Presented) A method of displaying clips comprising the steps of:
receiving at least two sets of an annotation and related content, the at least two sets being from non-contiguous portions of a document or portions of different documents;

combining said at least two sets to form a combination consisting of non-contiguous portions of a document or portions of different documents or both;

filtering said combination of said at least two sets; and

displaying the filtered combination of said at least two sets.

10. (Previously Presented) The method according to claim 9, further comprising the step of:

storing said combination of said at least two sets.

11-12. (Canceled)

13. (Previously Presented) A method of storing and accessing clips comprising the steps of:

receiving data regarding an annotation, and the data will include a user interface to allow various selections of an active content change when since the previous access session the active content has changed,

storing a link to context information with said annotation data in storage;

storing associations regarding at least two documents from which said annotation originates,

wherein selection of said annotation accesses the at least two documents to display said annotation based on the active content selection.

14. (Canceled)

15. (Previously Presented) A computer-readable medium having a program stored thereon, said program for displaying clips and comprising the steps of:

receiving at least two sets of an annotation and related content and the associated content will include a user interface to allow various selections of an active content change when since the previous renderable image upon the user interface, the active content associated with the annotation has changed;

combining said at least two sets to form a combination consisting of non-contiguous portions of a document or portions of different documents or both;

filtering said combination of said at least two sets based on the active content selection;
and

displaying the filtered combination of said at least two sets.

16. (Previously Presented) The computer readable medium according to claim 15, further comprising the step of:

storing said combination of said at least two sets.

17-18. (Canceled)

19. (Previously Presented) A computer-readable medium having a program stored thereon, said program for storing and accessing clips and comprising the steps of:

receiving data regarding an annotation, the at least two sets being from non-contiguous portions of a document or portions of different documents and the data will include a user

interface to allow various selections of an active content change when since the previous access session the active content has changed;

storing a link to context information with said annotation data in a storage;

storing associations regarding at least two documents from which said annotation originates,

wherein selection of said annotation accesses the at least two documents to display said annotation based on the active content selection.

20. (Canceled)

21. (Previously Presented) A system for showing clips of content and annotations comprising:

an input for receiving annotations associated with content;

a processor for creating a renderable image having clips, wherein at least one of said clips is a combination of two or more annotations and their associated content and the associated content will include a user interface to allow various selections of an active content change when since the previous renderable image upon the user interface, the active content associated with the annotation has changed, said processor executing instructions including

encompassing a first content and an associated annotation in a first bounding box,

encompassing second content and an associated annotation in a second bounding box, wherein the first and second bounding boxes are non-contiguous, and

combining the first bounding box and the second bounding box to form one of said clips based on the active content selection, and

an output for outputting said renderable image.

22. (Previously Presented) The system according to claim 21, wherein, prior to combining, the processor executed instructions which determine that the first bounding box and the second bounding box are within a threshold distance from each other in a document, wherein third content without an associated annotation is located in a third region located between a first and second regions.

23. (Previously Presented) A system for showing clips of content and annotations comprising:

an input for receiving annotations associated with content;

a processor for creating a renderable image having clips, wherein at least one of said clips is a combination of two or more annotations and their associated content and the associated content will include a user interface to allow various selections of an active content change when since the previous renderable image upon the user interface, the active content associated with the annotation has changed, said processor executing instructions including

encompassing first content and an associated annotation in a first region,

encompassing second content and an associated annotation in a second region, wherein the first and second regions are non-contiguous, and

combining the first region and the second region to form one of said clips based on the active content selection, and an output for outputting said renderable image.

24. (Previously Presented) The system according to claim 23, wherein prior to combining, the processor executes instructions which determine that the first region and the second region are within a threshold distance from each other in a document, wherein third content without an associated annotation is located in a third region located between the first and second regions.

25. (Previously Presented) The system according to claim 6, wherein said annotations are from different documents.

26. (Previously Presented) The system according to claim 25, wherein said documents are from different application programs.

APPENDIX B

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

APPENDIX C

No related proceedings are referenced in II. above, hence copies of decisions in related proceedings are not provided.